

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael MACH et al.

Serial No.: 08/460,715

Filed: June 2, 1995

For: STRUCTURAL PHOSPHO-
PROTEIN (PP28) OF HUMAN
CYTOMEGALOVIRUS (HCMV), THE
PREPARATION AND USE THEREOF

Group Art Unit: 1813

Examiner: D. Lee

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a Restriction Requirement dated January 21, 1998, the period for response having been extended by a petition for a four-month extension of time, and fee, filed herewith, the Office required restriction under 35 U.S.C. § 121 between following allegedly distinct species.

- Group I - Claims 7-8 (drawn to immunogenic pp28 protein); and
- Group II - Claims 5 and 17-18 (drawn to pp28 nucleic acids and host cells).

In compliance with MPEP 808.01(a), Applicants provisionally elect to prosecute the Group II claims (drawn to nucleic acids and host cells). Pending claims 5, and 17-18 read upon the claimed election.

Nevertheless, Applicants respectfully traverse the above requirement on the grounds that the Office has not established the two criteria necessary for restriction under MPEP § 803. A proper restriction requirement requires that the inventions be independent or distinct as claimed and a serious burden on the Examiner if the restriction is not required. Although the Office does allege that the claims of Group I

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and Group II fall into discrete classes, Applicants contend that the search of these classes will overlap to such an extent that a serious burden will not be imposed upon the Examiner to retain the claims in a single application. Specifically, Applicants point out that the method of preparing protein pp28 claimed in the provisionally non-elected claims of Group I may entail the expression of the same nucleic acids and host cells as described in Group II.

In the event that the Office does not consider the above traversal persuasive, Applicants recognize that upon allowance of a generic claim, the Office will consider claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed claim as provided by 37 C.F.R. 1.141.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, such extension is hereby requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed, including any fees required for an extension of time under 37 C.F.R. 1.136, please charge those fees to our Deposit Account No. 06-916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: June 19, 1998